

REMARKS

Reconsideration and allowance of the present application based on the following remarks is respectfully requested.

By this Amendment, claims 1-5, 7-21 and 23-30 are pending in the application. Claims 6 and 22 have been cancelled without prejudice or disclaimer of the subject matter recited therein. Claims 1-5, 7-21 and 23-30 have been amended to clarify the subject matter recited in the claims. Additionally, this Amendment adds an Abstract to the application and includes section headings in the Specification, as required by the outstanding Office Action. No new matter has been added.

The Office Action objected to the drawings because the block diagrams have no headings, only reference numbers. Applicant has amended Figure 2 to include headings for each element as identified in the concurrently filed Drawing Change Authorization Request. Accordingly, Applicant submits the objection is overcome.

The Office Action objected to the specification because the application did not contain an abstract, and because the specification did not include section headings. Applicant has amended the specification to include an Abstract and section headings. Accordingly, Applicant submits the objection is overcome.

The Office Action further objected to the Specification because of an alleged improper incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication. Applicant disagrees with the Examiner's conclusion. Applicant submits there is no need to amend the Specification to include the material incorporated by references because the subject matter is non-essential subject matter that does not require express incorporation. Applicant further submits that the references made within the Specification are for the purpose of indicating the background of the invention or illustrating

the state of the art, and thus, constitutes non-essential subject matter, as defined in MPEP §608.01(p)(I)(A). Accordingly, Applicant submits the objection is overcome.

The Office Action objected to claims 27 and 28 because of informalities. Applicant has amended claims 27 and 28 to remove the reference numbers. Accordingly, claims 27 and 28 are in form for allowance, and the objection is overcome.

The Office Action rejected claims 1-30 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 6 and 22 have been cancelled. Therefore, the rejection as applied to cancelled claims 6 and 22 is rendered moot. Applicant has amended the claims to better clarify the subject matter of the invention. Reconsideration and withdrawal of the rejection of claim 1-30 are requested.

The Office Action rejected claims 1-15 under 35 U.S.C. §101 because claim 1 did not set forth any steps involved in the method/process. Claim 6 has been cancelled without prejudice or disclaimer of the subject matter recited therein. Therefore, the rejection, as applied to cancelled claim 6, is rendered moot. Applicant has amended claims 1-5 and 7-15 to properly recite the method for billing for the present invention. Reconsideration and withdrawal of the rejection of claims 1-15 are requested.

The Office Action rejected claims 1-15 under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. In particular, the Office Action states that the process of claim 1 is not enabled because it claims billing the user before the counter incremented. Applicant has amended claim 1 to clarify the method process such that the user is billed after the counter is incremented and the amount to be billed is determined (See, Amended claim 1).

The Office Action rejected claim 19 under 35 U.S.C. §112, first paragraph as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. Applicant has amended claim 19 to clarify that the usage of resources is counted independently and recorded independently in the SIM card. Specifically, when a resource is used, the corresponding counter is incremented (Specification at page 8, line 28- page 9, line 7). The amount counted by the counter is compared to a pre-defined amount stored in the card, and is only charged when the amount counted by the counter exceeds the pre-defined amount (Specification, at page 9, lines 12-14). The counted amount is turned into a billing record. Applicant notes that it is possible to deduct fees directly from money stored on the SIM card, or in cases in which the fees are not charged to an account inside the card, the billing record with the amount to be billed is prepared and transmitted to a sub-fee collector (Specification, page 9, lines 21-24). Reconsideration and withdrawal of the rejection of claim 19 are requested.

The Office Action rejected claims 16, 18, 20, 21, 24 and 28 under 35 U.S.C. §102(e) as being anticipated by Croughwell et al. (U.S. Patent No. 5,966,654). Applicant traverses the rejection because Croughwell fails to teach or suggest each feature recited in the claims of the present invention. In particular, Croughwell fails to teach a SIM card having "at least one counter that is incremented when one of a software resource and hardware resource" of the SIM card is used, and "a mechanism configured to determine an amount to be billed from a counter value", as recited in claim 16.

Croughwell merely discloses a recyclable cellular telephone having a limited period of use. The electronics of the telephone operate to disable the telephone following expiration of the period of use (See Abstract). The Office Action states that Croughwell shows all elements of the claim including counters. However, Applicant submits that the counters 100

and 102 of the Croughwell disclosure are located in either a CPU (92) or a Data Storage (98), not in the SIM card as recited in claim 16 (See Figure 3 of Croughwell).

Since Croughwell fails to teach or suggest a SIM card having at least one counter, Croughwell fails to teach each element recited in the claims of the present application, and thus, fails to anticipate the present application. As such, claim 16 is patentable over Croughwell.

Claims 18, 20, 21, 24 and 28 depend from independent claim 16. By virtue of their dependence from claim 16, claims 18, 20, 21, 24 and 28 also include the subject matter recited in claim 16, and are patentable over Croughwell.

Reconsideration and withdrawal of the rejection of claims 16, 18, 20, 21, 24 and 28 are requested.

The Office Action rejected claims 17 and 22 under 35 U.S.C. §103(a) as being unpatentable over Croughwell. Claim 29 was rejected under 35 U.S.C. §103(a) as being unpatentable over Croughwell in view of Martineau (WO 97/40616). Claim 22 has been cancelled without prejudice or disclaimer of the subject matter recited therein. Therefore, the rejection, as applied to cancelled claim 22, is rendered moot. Applicant traverses the rejection because neither Croughwell nor Martineau, analyzed alone or in any proper combination, teaches or suggests all the combined features recited in the present invention.

The Office Action states that Croughwell discloses all elements of the claim except a contactless interface, as recited in claim 17, and updating fee tables over the air, as recited in claim 29. To overcome the deficiencies of the Croughwell disclosure, the Office Action relies upon a broad statement of what is known in the art for adding a contactless interface, and the teachings of Martineau for updating the fee table.

Claims 17 and 29 depend from independent claim 16. By virtue of their dependency from claim 16, claims 17 and 19 also include the subject matter of claim 16. Applicant respectfully submits that even if a contactless interface were added to the Croughwell device, and the teachings of Martineau were used to update the fee table, the modified Croughwell device would still fail to teach or suggest all the combined features of the present invention. Specifically, the modified device would fail to provide a SIM card for use in a telecommunications network, comprising at least one counter that is incremented when one of a software resource and hardware resource is use, and a mechanism configured to determine an amount to be billed from a counter value, as recited in claim 16. Since the modified device would fail to provide all the combined features recited in the present invention, claims 17 and 29 are patentable over the applied references. Reconsideration and withdrawal of the rejection of claims 17, 22 and 29 under §103(a) are requested.

All the stated grounds of objection and rejection have been properly traversed. In view of the foregoing, the claims and specification are now believed to be in form for allowance, and such action is hereby solicited. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to call the undersigned at the telephone number provided below.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached Appendix is captioned **"Version with markings to show changes made"**.

Respectfully submitted,

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Enclosure: ABSTRACT OF DISCLOSURE
APPENDIX

APPENDIX
VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE SPECIFICATION:

The specification is changed as follows:

Change the paragraph beginning on page 1, line 6 as follows:

The present invention follows from the observation that fees charged for using resources in a telecommunications network can be divided into three layers [(Figure 1)], as illustrated in Figure 1.

Change the paragraph beginning on page 1, line 9 as follows:

In Figure 1, located [Located] in the lowest layer L are the license fees, which must be paid to different licensers for the usage of protected hardware and software resources. Each resource in a telecommunications system can be subject to license fees. Generally, the network operator pays these license fees to the licenser; however, the end user only pays this license fee indirectly through traffic fees paid to the network operator.

Change the paragraph beginning on page 2, line 12 as follows:

According to the invention, [these]the different groups of fees of Fig. 1 are determined and billed separately and independently.

Change the paragraph beginning on page 4, line 6 as follows:

In Fig. 2, reference [Reference] numeral 1 relates to a terminal device, for example a GSM mobile radio telephone or a computer with communications possibilities. The device 1

contains a SIM card 10 (Subscriber Identity Module) which identifies the user in the telecommunications network 2. SIM cards are currently being used in GSM-, DCS-, or PCS mobile devices, among others, or also in future fixed networks with user identification through chipcards. The SIM card can be either a full-size card or a plug-in card. It is connected to the terminal device 1 by means of a contact area on the surface of the card. The SIM card 10 contains data processing means 100, for example a known GSM SIM-processor. SIM cards are described, for instance, in the technical specifications GSM 11.11 or GSM 11.14, available since 1995 or 1996, respectively, at the office of the European Telecommunications Standards Institute, in F-06921 Sophia Antipolis.

Change the paragraph beginning on page 8, line 9 as follows:

The network operator and/or the various service providers and licensors can add to or adapt the fee table 1001 [1002] in the already distributed SIM cards by means of encrypted special SMS short messages. A change of tariffs can then be carried out in an easy manner in that these fee tables in the SIM cards are adjusted as already described in the patent application EP734144. Similarly, the fees charged are transmitted to the recipients by means of SMS messages, as will be explained further below.

Change the paragraph bridging pages 8 and 9 as follows:

When a resource is used, for instance one of the above-mentioned resources subject to one or more fees, the corresponding counter is incremented. The increment value may be fixed or it may depend on the duration of the usage, for example, or on other parameters, for example time of day, day of the week, location, user category, etc. The increment value may also depend on the fee table 1001 [1002]. Moreover, the usage of one single resource may

cause more than one counter to increment, for example a first counter for the license fees, a second counter for traffic fees, and a third counter for the service fees.

Change the paragraph beginning on page 9, line 8 as follows:

The charged fee amounts are sometimes very small; specifically, the amount for license fees charged for the usage of a specific resource in the card can be small. In order to avoid a great number of transactions with small amounts, these amounts are preferably not immediately charged to the users. For that purpose, the amount counted by the counter is compared to a pre-defined amount stored in the card, and it is only charged when the amount counted by the counter exceeds the pre-defined amount. If the fee table is not taken into consideration in the incrementation step, this counted amount is turned into a billing record using the fee table 1001 [1002].

Change the paragraph beginning on page 9, line 21 as follows:

However, most of the fees are not charged to an account inside the card. Instead, a billing record with the amount to be billed is prepared and transmitted to a sub-fee collector of the SIM server 1 [<sic.4>] during or after usage. However, a billing record is preferably only prepared and transmitted when the counter value exceed the pre-defined amount or only after a pre-defined number of times of use. In a variant, this billing record is not sent by the card 10, but periodically queried by the sub-fee collector 42.

IN THE CLAIMS:

Claims 6 and 22 have been cancelled.

1. (Twice Amended) A [Billing] billing method for billing a [the] user for the usage of resources [(A-F)] in a SIM card [(10)] in a telecommunications network [(2)], in which the resources are not responsible for the traffic process, [characterized in that] comprising:

[the use is billed for software resources and/or hardware resources of the SIM card 10, at least one counter in the SIM card is incremented when a said billed-for software resource and/or hardware resource is used in the SIM card (10), and

the amount to be billed is determined from the counter value, which amount corresponds to a service fee and/or license fee.]

incrementing at least one counter in the SIM card when at least one of a software resource and a hardware resource is used in the SIM card;

determining an amount to be billed from a counter value, provided by the at least one counter in the SIM card, wherein the amount to be billed corresponds to at least one of a service fee and a license fee; and

billing the user for at least one of the software resources and the hardware resources used in the SIM card.

2. (Amended) The [Billing] billing method according to claim 1, [characterized in that] wherein at least one billed-for resource is a contactless interface [(A-F)].

3. (Twice Amended) The [Billing] billing method according to claim 1, [characterized in that] wherein at least one billed-for resource is [responsible for] based upon the use of the SIM card [(10)] in [another] an external system [(10-12)].

4. (Twice Amended) The [Billing] billing method according to claim 1, [characterized in that] further comprising individually billing a plurality of resources [(A-F)] independently in the SIM card [(10)].

5. (Twice Amended) The [Billing] billing method according to claim 1, further comprising incrementing the at least one counter [is incremented depending on] based upon the duration of usage of the respective billed-for resource.

7. (Twice Amended) The [Billing] billing method according to claim 1, further comprising offering the at least one billed-for resource [is offered] by an external service provider [(3) and that billed], wherein the amount to be billed corresponds to a service fee for use of the offered service.

8. (Twice Amended) The [Billing] billing method according to claim 1, [characterized in that with] further comprising incrementing more than one counter to correspond to different types of fees applied to the use of a single resource [the use of at least one single resource more than one counter (1002, 1002') is incremented, which counters corresponds to different types of fees.].

9. (Twice Amended) The [Billing] billing method according to claim 1, [characterized in that] further comprising displaying the amount to be billed [can be displayed] on a mobile device [(1)] in which the SIM card [(10)] is inserted.

10. (Twice Amended) The [Billing] billing method according to claim 1, [characterized in that] further comprising charging the amount to be billed [is charged] to a pre-paid account in the SIM card.

11. (Twice Amended) The [Billing] billing method according to claim 1, [characterized in that] further comprising:
preparing a billing record with the amount to billed; [is prepared] and
transmitting the billing record to a billing center [(42)] in said telecommunications network [(2)].

12. (Twice Amended) The [Billing] billing method according to claim 11, [characterized in that] further comprising comparing [the] an amount counted by the counter [is compared] to a pre-defined amount, wherein the billing record is only prepared when the amount counted by the counter exceeds the pre-defined amount.

13. (Twice Amended) The [Billing] billing method according to claim 11, [characterized in that] further comprising transmitting the billing record [is transmitted] via said telecommunications network by means of SMS messages.

14. (Twice Amended) The [Billing] billing method according to claim 1, [characterized in that] further comprising determining the amount to be billed [is determined depending on] based upon a fee table [(1000)] stored in the SIM card.

15. (Twice Amended) The [Billing] billing method according to claim 14, [characterized in that said] further comprising changing said fee table [(1000) can be changed,] remotely [controlled], by means of SMS messages from another location in said telecommunications network [(2)].

16. (Twice Amended) A SIM card [(10)] for [users of] use in a telecommunications network [(2)] in which [can be] the SIM card may be inserted into a terminal device [(1)] in a removable manner, [and which comprises] comprising data processing means [(100)] to [enabling] enable the storing of data, [which] wherein the data contains at least identification data of [the] a user in the telecommunications network [(2)], [characterized in that] wherein

the SIM card [(10)] further [contains] comprises at least one counter[, which] that is incremented when one of a software resource [and/or] and hardware resource[, not responsible for the traffic process[, of the SIM card is used[, and

a mechanism configured to determine an amount to be billed [an amount to be billed to the user is determined] from [the] a counter value, [which] wherein the amount to be billed corresponds to one of at least a service fee [and/or] and a license fee.

17. (Twice Amended) The SIM card according to [the preceding claim, characterized in that] claim 16, wherein at least one billed-for hardware resource contains a contactless interface [(A-F)].

18. (Twice Amended) The SIM card according to claim 16, [characterized in that] wherein at least one billed-for resource is [responsible for the] based upon use of the SIM card in an external system.

19. (Twice Amended) The SIM card according to [one of the claims 16 to 18, characterized in that] claim 16, wherein the usage of a plurality of resources [(A-F)] is counted independently and [billed] recorded [for] independently in the SIM card.

20. (Twice Amended) The SIM card according to [one of the claims 16 to 19, characterized in that] claim 16, wherein at least one counter is incremented depending on the duration of the usage of the respective billed-for resource.

21. (Twice Amended) The SIM card according to [one of the claims 16 to 20, characterized in that] claim 16, wherein at least one billed-for resource [is protected by patent and that the billed amount] corresponds to a license fee for [using this] use of the resource.

23. (Twice Amended) The SIM card according to [one of the claims 16 to 22, characterized in that with] claim 16, wherein the use of at least one single resource[,]
activates at least one of a plurality of counters [(1002, 1002') are] to [incremented] increment,
[which] said plurality counters correspond to different types of fees.

24. (Twice Amended) The SIM card according to [one of the claims 16 to 23, characterized in that it additionally] claim 16, further [comprises] comprising means to debit the billed amount from a prepaid account in the SIM card [(10)].

25. (Twice Amended) The SIM card according to claim 16 [characterized in that it further comprises] further comprising:

means to prepare a billing record with the amount to be billed; and

means to transmit the billing record to a billing center [(42)] in said telecommunications networks [(2)].

26. (Twice Amended) The SIM card according to [the preceding claim] claim 25, [characterized in that it further comprises] further comprising means to compare the amount counted by the counter with a pre-defined amount and to prepare said billing record as soon as the amount counted by the counter exceeds the pre-defined amount.

27. (Twice Amended) The SIM card according to claim 25, [characterized in that] wherein the billing records are transmitted via said billing center in said telecommunications network by means of SMS messages.

28. (Twice Amended) The SIM card according to [one of the claims 16 to 27] claim 16, [characterized in that] wherein the billed amounts are dependent upon a fee table [(1000)] stored in the SIM card.

29. (Twice Amended) The SIM card according to [the preceding claim] claim 28, [characterized in that] wherein said fee table [(1000)] can be changed, remotely controlled, by means of SMS messages from another location in the telecommunications network.

30. (Twice Amended) The SIM card according to [one of the claims 25 to 29] claim 25, [characterized in that it comprises] further comprising TTP encryption means, by means of which the billing records can be signed and encrypted.

END OF APPENDIX